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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,264	11/08/2001	Pascal Simon	209858US55	6595

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ALEXANDRIA, VA 22314

EXAMINER

TRAN, SUSAN T

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,264

Applicant(s)

SIMON, PASCAL

Examiner

Susan T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-114 is/are pending in the application.
- 4a) Of the above claim(s) 41-51 is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 and 52-114 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/08/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of applicant's Request for Extension of Time filed 11/15/04, and Information Disclosure Statement filed 03/08/05.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bechmann et al. (US 6508604), in view of Beck et al. (WO 01/54661 A1).

Bechmann teaches an article comprising a fluid or solid containing cell or capsule within a substrate structure (Col. 2, lines 13-27). The cell contained within the article is burstable upon pressure or an opening means (Col. 3, lines 8-50). The article can dispense solid or liquids for mixing different materials to cause chemical reaction or exposing the materials to cause reactions that produce energy or heat flow to aid in the end use of the product (Col. 3, lines 16-50). The cell or capsule contains a fluid or solid, particles, powders, granules or a gas (Col. 3, lines 51-63). The cells can be any shape or dimension and rupture upon applying pressure (Col. 4, lines 2-49). The cell has various means for aiding in the bursting of the cell (Col. 6, line 10 - Col. 7, line 53). The body of the article can be made of various materials such as fibrous pads and

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absorbent materials (Col. 8, lines 40-67). The article can also be packaged in a container (Col. 7, line 54 - Co. 8, line 39). The article further comprises a flow control means, which can be a grid like material inside the article to aid in controlling the flow and distribution of a liquid out of the inner cell compartment (Col. 9, lines 1-61).

Bechmann does not expressly teach an outer substrate that has a cosmetic composition associated with it.

Beck teaches a cleansing article comprising a substrate sheet with two layers, a cleansing component disposed adjacent to the substrate sheet and a therapeutic component disposed adjacent the substrate sheet (Page 2-3, Invention Summary). The article is used to cleanse and condition the skin and hair by wetting the article with water and contacting the skin or hair with the wetted article. (Page 2-3, Invention Summary). Various materials can be used for the first and second layer of the substrate sheet (Pages 4-11). The layers are bonded together in various ways as well (Pages 11-12). The cleansing component can be a surfactant of various types (Pages 12-22). The therapeutic agents are defined on Pages 23-34. The article can further contain multiple chambers containing different surfactants and/or conditioning agents (Page 36). The concept of the Beck reference is a multi-layer substrate comprising at least two layers wherein a surfactant and conditioning therapeutic agents are associated with the substrate so that when wetted the article can cleanse and condition the hair and skin of the user. The reference teaches a suitable substrate composition that is known to treat the skin.

At the time the invention was made, it would have been obvious to a person of

ordinary skill in the art to combine the concept of a multi-layer substrate with a surfactant and/or therapeutic agents disposed between the layers so that when wetted provide a cleansing article for the skin with the concept of a multi-layer substrate with a capsule to deliver a liquid to provide a cleansing article for the skin. Therefore, it would be obvious to prepare an article that has a multi-layer substrate with a surfactant and/or therapeutic agent associate with the substrate wherein the device also has a capsule that is breakable to deliver the liquid needed to wet the device and provide a cleansing property. Both references teach articles that are used to treat or condition the skin. Bechmann teaches the article containing the capsule to deliver a liquid used to treat, cleanse or condition the skin. Beck teaches one substrate that suitable for skin cleansing that could be used to form the article of Bechmann.

One of ordinary skill in the art would have been motivated to do this to provide a disposable, easily stored, portable device that can benefit the user by providing a specific outcome when used (cleansing, polishing, deodorizing, or disinfecting (Bechmann, Col. 3, lines 8-35). Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made.

Claims 52-114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bechmann et al. (US 6508604) in combination with Beck et al. (WO 01/54661 A1) and Gruenbacher et al. (US 6669387).

The teachings of Bechmann and Beck are discussed above. Bechmann and Beck do not expressly teach 3 or more layers for their articles.

Gruenbacher teaches an applicator with an internal cavity that contains a reservoir that is rupturable wherein the material contained in the reservoir is distributed to the articles surfaces (Col. 2, lines 20-36). The article can be a mitt, pad or wipe (Col. 3, line 1). The applicator has front outer and inner surfaces as well as back outer and inner surfaces (Col. 3, lines 41-67). The reservoir contains liquids, gels, lotions, creams, powders or solids (Col. 4, lines 17-25). This reservoir can be in various locations throughout the articles and more than one reservoir can be used (Col. 5, lines 27-48). The article further contains a flow restriction layer, which controls the rate of flow of the liquid through the outer substrates (Col. 6, lines 51-67). Still further, an absorbent layer or layers can also be included in the article (Col. 9, line 57 - Col. 10, line 41). Barrier layers are also included to protect the users hand from the solid or liquid contained in the reservoir (Col. 10, lines 43-67). The back panel of the article can be an absorbent material to wipe off excess product during use (Col. 12, lines 1-54). Water is one material that can included in the reservoir of the article (Col. 13, lines 50-57).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to prepare an article containing multiple layers, of both absorbent or permeable layers as well as barrier or impermeable layers further containing a liquid in a internal reservoir to be distributed to the outer substrates to provide a cleansing article for various surfaces.

One of ordinary skill in the art would have been motivated to do this to provide an article that applies the product directly on the target surface with greater efficiency and

avoids the product contacting the surface adjacent to the target surface that may be sensitive to the material in use. The article can eliminate or reduce performance and safety issues (Gruenbacher, Col. 14, lines 22-34). Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

Applicant's arguments filed 11/15/04 have been fully considered but they are not persuasive.

Applicant argues that there is no motivation or suggestion to combine Bechmann and Beck, because nowhere does Beck desire to control the amount of water to which the article is exposed. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of

ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In the instant case, Beck is relied upon solely for the teaching of an outer substrate.

Beck teaches a cleansing article comprising a substrate sheet with two layers, a cleansing component disposed adjacent to the substrate sheet and a therapeutic component disposed adjacent the substrate sheet (Page 2-3, Invention Summary).

Applicant argues that there is nothing in either publication which describes a container with a means to break the capsule. In response to applicant's arguments, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In response to applicant's argument that the reference does not show certain feature of applicant's invention, it is noted that the feature upon which applicant relies (i.e., a means to break the capsule) is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In any event, applicant's attention is called to Bechmann at column 3, lines 8-50, where Bechmann discloses the cell contained within the article is burstable upon pressure or an opening means. The cell or capsule contains a fluid or solid, particles, powders, granules or a gas (column 3, lines 51-63). The cells can be any shape or dimension and rupture upon applying pressure (Col. 4, lines 2-49). The cell has various means for aiding in the bursting of the cell (Col. 6, line 10 - Col. 7, line 53).

Applicant argues that there is no motivation to combine Bechmann, Beck, and Gruenbacher because the references are directed towards different purposes and objectives as compared with the present invention, and therefore, fail to disclose or suggest the advantages achieved by the present invention. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Applicant recognizes that the references teach solutions to similar problems (see Remarks page 5, last 2 lines). Accordingly, it appears that the references teach similar subject matters, and therefore, provide suggestions to combine or to modify to produce the claimed invention. Regarding to the statement that the references fail to disclose or suggest the advantages achieved by the present invention, it is not necessary for the prior art show each and every property of the claimed product (see *In re Best, Bolton and Shaw* (CCPA) 195 USPQ 430, 10/13/1977).

Pertinent Arts

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pahlck et al., Lambrechts, Hasse, Banik et al., Perrier et al., and

Hamer et al. are cited as of interest for the teachings of cosmetic compositions comprising breakable capsule, bead, or microcapsule.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan T. Tran whose telephone number is (571) 272-0606. The examiner can normally be reached on Monday through Thursday 6:00 am to 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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